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MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

RIMELL, SAMUEL G

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 25

Application Number: 09/121,596
Filing Date: July 24, 1998
Appellant(s): MAYAUD, CHRISTIAN

David L. Stewart of
McDermott Will & Emery
For Appellant

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Technology Center 2100

EXAMINER'S ANSWER

This Examiner's Answer is in response to the appeal brief filed March 1, 2002.

(1) *Real Party in Interest*

A statement identifying the real party of interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The issues recited by appellant are substantially correct, except that the issues are whether or not the claims have been properly rejected.

(7) *Grouping of Claims*

Appellant states that each of the claims have been argued separately, but the arguments reveal several claims that are not argued separately. Claim 72 is acknowledged to stand with claim 70. Claims 70 and 99 and claims 79 and 80 are presented together as groups. With these exceptions, the claims are argued separately.

Art Unit: 3626

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is substantially correct, except that it is missing claims 72 and 95-98. The missing claims can be obtained from the file record.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

(1) U.S. Patent 5,833,599 Schrier et al. : Published 10 November 1998,
Effective Filing Date of 13 December 1993.

(2) U.S. Patent 5,867,821 Ballantyne et al. : Published 2 February 1999,
Effective Filing Date of 11 May 1994.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

(1) Claims 70, 72-83, 91-92, 94-99 and 101-102 are rejected under 35 USC 102(e) as being anticipated by Schrier et al. The reasons for this rejection were set forth in the office action of 15 October 2001 and are hereby incorporated by reference.

(2) Claims 84-90 and 100 are rejected under 35 USC 103(a) as being unpatentable over Schrier et al. in view of Ballantyne et al. The reasons for this rejection were set forth in the office action of 15 October 2001 and are hereby incorporated by reference.

(11) Response to Arguments

Examiner's presentation of arguments will run parallel to appellant's presentation of arguments.

It is first noted that appellant has not discussed or presented any arguments that address the various quotations cited from both the Schrier et al. or Ballantyne et al. references recited in the final rejection. Appellant's arguments are essentially a listing of blanket assertions that do not consider these citations, or the arguments accompanying the citations.

Claims 70 and 99: Appellant argues that the reference to Schrier et al. does not disclose groups, such as an HMO, an insurance company, a drug benefit plan, a laboratory, etc. In the context of claims 70 and 99, these groups are presented as the entities who either "run" the equipment or who benefit from the operation of the equipment. Examiner has taken the position that no patentable weight can be attributed to the nature of the entities who run the equipment, the beneficiaries of the equipment operation or the owners of the equipment. Examiner's rationale is that both the method and the product remain the same regardless of who actually is designated as the equipment operator or beneficiary or owner. A method of sending data to a computer remains the same regardless of who owns or operates the receiving computer. Similarly, a computer program product that calls for a first computer to communicate with a second computer is not altered if the second computer is owned by pharmacy A as opposed to being owned by Hospital B. The computer itself and the program to communicate with the computer remain the same.

Even assuming that one did attribute patentable weight to such a feature, Examiner maintains that some of the entity groupings of claims 70 and 99 are suggested by Schrier et al.

Art Unit: 3626

Col. 5, line 19 of Schrier et al. states that its computer is part of a hospital information system, which means that it must communicate with other departments of a hospital. These other departments read as “physician practice.” Hospitals also include laboratories and pharmacies.

Claim 72: Claim 72 is acknowledged to stand with claim 70. No arguments are presented.

Claim 73: Appellant argues that Schrier et al. does not disclose the step of gathering information from other computers and presenting that information on a graphical user interface. In other words, Appellant is arguing that the computer of Schrier et al. stands alone and does not communicate with other computers. However, column 5, lines 18-24 of Schrier et al. indicates that the system computer of Schrier et al. operates within a network. Appellant has not established or provided any evidence or factual information beyond a blanket assertion that Schrier et al. lacks this feature.

Claim 74: Appellant argues that Schrier et al. does not disclose the step of compiling information from other computers into a prescription history. However, Column 5, lines 18-24 clearly illustrate the interaction of network computers to compile patient data which may also include a prescription history (Co. 6, lines 5-11 and FIG. 11, block 312).

Claim 75: Appellant argues that Schrier et al. does not suggest the step of gathering information from other computers and compiling information about pharmaceuticals. However, Col. 5, lines 18-24 clearly illustrate the interaction of network computers to compile data, including information about pharmaceuticals (col. 5, line 24 in particular).

Claim 76: Appellant argues that Schrier et al. does not suggest the step of gathering information from other computers and compiling information about properties of

Art Unit: 3626

pharmaceuticals. However, column 5, lines 18-24 clearly illustrate the interaction of network computers to compile data, including data on pharmaceutical properties (FIGS. 6, 7, 10-22).

Claim 77: Appellant argues that Schrier does not disclose the step of sending a prescription to a pharmacy by using a graphical user interface. However, Schrier et al. discloses exactly such a feature (see col. 14, lines 65-67).

Claim 78: Appellant argues for the patentability of claim 78 based on its dependence on claim 70. Claim 70 remains rejected, and by such argument, claim 78 remains rejected as well. Appellant also points out a feature recited in claim 78, but does not state how this relates to Schrier et al. Presumably, appellant is arguing that Schrier et al. does not disclose a selective arrangement of data in its databases. However, Schrier et al. teaches arrangement of data in order of prescription to a user (col. 15, line 6) and alphabetical order (232 in FIG. 3).

Claims 79-80: Appellant argues that Schrier et al. does not teach the step of arranging drugs in order of body system or drug category. However, 234 in FIG. 3 of Schrier et al. illustrates arrangement of data by drug categories, with certain categories being specific to treatment of particular body systems.

Claim 81: Appellant argues that Schrier et al. does not teach the suggestion of alternative pharmaceuticals for specific disease condition. However, this is clearly illustrated in FIG. 9.

Claim 82: Appellant argues that Schrier et al. does not teach or suggest guidelines for the alternative pharmaceuticals. However, FIG. 9 illustrates dosage guidelines for each available alternative.

Claim 83: Appellant argues that Schrier et al. does not disclose the step of arranging information about a patient's prescription history by condition. However, FIG. 11 illustrates

Art Unit: 3626

where medical conditions, such as the need for medications and the presence of pain are listed on a prescription history.

Claim 91: Appellant argues that Schrier et al. does not disclose the steps of interrogating databases and assembling information in chronological order. However, col. 5, lines 18-24 suggest the interrogation of other databases, while FIG. 11 illustrates the prescription history presented in chronological order using time and date stamps to establish chronology.

Claim 92: Appellant argues that Schrier et al. does not disclose the concept of discarding a version of the patient's medical history without creating file copy. Examiner maintains that this is an inherent feature of a standard computer system with a random access memory. An updated file can be saved by replacing the updated file with the original file. A new file need not be created.

Claim 94: Appellant argues that Schrier et al. does not communicate with a network of computers and does not capture information about prescriber activity. As stated herein, the reference to Schrier et al. does disclose communication with other network computers to obtain and exchange data (col. 5, lines 18-24). This information may include prescriber activity, which is repeatedly illustrated throughout Schrier et al (FIG. 2; FIG. 11; col. 6, lines 4-11; col. 21, lines 30-65).

Claim 95: Appellant argues that the prescriber data cannot be shared. However, the communication and data sharing between Schrier et al.'s system computer and other network computers is well established (col. 5, lines 18-24).

Claim 96: Appellant argues that Schrier et al. does not disclose information that identifies the prescriber. However, Schrier repeatedly illustrates the establishment of such data (see col. 15, line 6 and col. 21, line 42).

Claim 97: Appellant argues that Schrier et al. does not teach contact information for a prescriber. The "Health ID" number illustrated in col. 21, line 42 of Schrier et al. reads as contact information.

Claim 98: Appellant argues that the system computer of Schrier et al. does not store data on suggested medication dosages. However, this is illustrated in FIG. 5.

Claim 99: Appellant argues that Schrier et al. does not disclose a computer program product that contains instructions for accessing information about prescription history, information about pharmaceuticals and information about properties of pharmaceuticals. However, Schrier et al. discloses a computer system that can access all three types of data. Access to a prescription history (Col. 6, lines 5-11 and FIG. 11, block 312); access to a list of pharmaceuticals (FIG. 9 or FIG. 11) and access to properties of pharmaceuticals (FIG. 4; FIG. 6; FIG.9) are illustrated in Schrier et al.

Claim 101: Appellant argues that Schrier et al. does not interrogate other computers and does not present information in chronological order. Examiner maintains that Schrier et al. discloses these features. See col. 5, lines 18-24 for interrogation of other computers and FIG. 11, block 312 for presentation of data based on a time and date stamp.

Claim 102: Appellant argues that Schrier et al. does not disclose a computer program containing instructions for communicating with other system computers, and for accessing medical history, therapeutic agents and prescriber activity. The contact and exchange of data

Art Unit: 3626

with other system computers is illustrated in Col. 5, lines 18-24. Medical history, a listing of therapeutic agents and prescriber activity are each illustrated in FIG. 11. The data fields for intake of such data are illustrated throughout col. 21 of Schrier et al.

Claims 84-90 and 100: These claims were rejected under 35 USC 103 by the combination of Schrier et al. and Ballantyne et al. Appellant argues that the “personal digital assistant” set forth in the claims of this set are not the same as the “personal data assistant” described in Fig. 1 of Ballantyne et al.

The resolution to this question can be derived from a review of appellant’s own disclosure pertaining to the description of the “personal digital assistant”. Appellant’s own specification at the last line of page 19, the first line of page 20, and the 20th line of page 20 provide the necessary definition for the personal digital assistant (PDA). In appellant’s specification, these PDA devices are described as “hand held” and “keyless or minimally keyed”. Thus, if the personal data assistant of Ballantyne et al. has these features, it can properly be construed as a “personal digital assistant”.

Ballantyne et al. describes the PDA device as capable of functioning as a pager (col. 15, line 35), which means that the device is clearly hand held. In addition, FIG. 2 illustrates the device as being keyless, and accepting only pen based input. Given these characteristics, the device of Ballantyne et al. is clearly a personal digital assistant, by appellant’s own self-provided definition.

Appellant further argues that the PDA device of Ballantyne et al. has no advantage of mobility because it is locked to a nursing station. However, the suggestion of using the Ballantyne et al. PDA device as a pager (col. 15, line 35) clearly contradicts such an argument.

Art Unit: 3626

Appellant's remaining arguments pertain to prescription information and prescription information as presented on predefined lists. Such predefined lists are illustrated by Schrier et al., as shown in FIGS. 9-11.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Sam Rimell
Primary Examiner
Art Unit 3626

May 16, 2002

Conferees

MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100



DOV POPOVICI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100